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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,807	11/12/1999	MICHAEL MARCASE	D5381-00001	2131

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DUANE MORRIS, LLP
IP DEPARTMENT
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103-4196

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

MAIL DATE	DELIVERY MODE
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03/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/439,807	Applicant(s) MARCASE, MICHAEL	
	Examiner Sebastiano Passaniti	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is supplemental to the petition decision, mailed 12/28/2007, and in consideration of the reply to the April 24, 2002 Office action. According to the petition decision, the reply was timely filed on July 23, 2002. A copy of the response was received with the petition, filed 03/16/2007.

The examiner in charge of this application has changed. Updated correspondence information is included at the end of this Office action.

Claims 13 and 14 have been canceled, as directed by the applicant.

Claims 1-12 and 15-20 remain pending.

Following is an action on the MERITS:

The indicated allowability of claims 14 and 15 is withdrawn in view of the newly discovered reference(s) to Baird (U.S. Patent 5,643,106) and Tananpai (JP3224578). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baird (U.S. Patent 5,643,106) in view of Tananpai (JP3224578). The patent to Baird shows every feature with the exception of a serrated leading edge at the juncture of the sole and the striking face. Tananpai shows it to be old in the art to provide the

Art Unit: 3711

leading edge with a plurality of teeth that collectively resemble a saw-tooth shape in order to enable the club head to pass through the turf or sand material during a follow through. Note Figures 1A and 2. In view of the patent to Tananpai, it would have been obvious to modify the device in the cited art reference to Baird by providing the Baird device with a serrated leading edge, the motivation being to provide a leading edge that is better equipped to slice or move through the turf during a forward swing. A forward swing that is less impeded by the resistance of the turf is more likely to transfer the full impact of the striking face to a struck golf ball and thereby enhance the flight characteristics of the ball. As to the remaining limitations in the claims and with respect to the Baird reference, note club head (10) in Baird showing a sole (15) and striking face (11). Note the leading edge (19) that is formed by the edges of the sole and the striking face meeting at a sharp angle in a plane along an axis that extends generally from heel to toe. The sole includes a protrusion (17). As to claim 11, the angle between the striking face and a vertical plane appears to be between 45 and 60 degrees, as evidenced by a comparison of Figures 1 and 3 in Baird with Figure 2 in applicant's disclosure. As to claim 12, the angle between the striking face (11) and the sole (15) would appear to be between 20 and 30 degrees. As to claim 15, while Baird, as modified by Tanapai, does not show the specific, claimed limitations regarding the distance between adjacent troughs of the leading edge, Tanapai states that the length, shape and number of teeth may be adjusted as desired (abstract). Clearly, the skilled artisan would have found it obvious to modify the characteristics of the troughs of the leading edge in order to change the resistance between the knife leading edge of the

Art Unit: 3711

blade and the turf, based upon the preferences of an individual golfer. As to claims 16 and 17, while Baird does not detail the specifics of the thickness of the blade or the dimension from the leading edge to the trailing edge, it would have been obvious to provide the Baird device with these limitations, as the limitations are indicative of what would generally be found in a club of the wedge-type. Moreover, the dimensions of the club head per se are not deemed critical. As to claim 18, the approximate 10 degree angle would appear to be evident from a review of Figure 1 in Baird. As to claim 19, Baird includes a hosel (25) and shaft (30). As to claim 20, the striking face in Baird includes grooves and thus is "abrasive", as broadly as claimed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 and 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "knife-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). Here, for example, knives may have a sharp edge or a blunt edge. There is no way of ascertaining exactly how the shape of the leading edge is structured.

Claims 2-12 and 15-20 share the indefiniteness of claim 1.

Allowable Subject Matter

Claims 2-10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1-12 and 15-20 have been considered but are moot in view of the new ground(s) of rejection.

Further References of Interest

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note Figure 2 in Brown. Note the serrated edge in Ootoguro. See Figure 4 in Meyer. Note dowels (17) in Sun. See edge (20) in Raymond. Observe Figure 2 in Suganuma. See Figures 1 and 2 in Perkins. See Figure 2 in Thompson. Note front edge (32) in Schonher. See tines (8) in Consoli.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sebastiano Passaniti/
Primary Examiner
Art Unit 3711

S.Passaniti/sp
March 11, 2008